

THIS ORDER IS NOT A
PRECEDENT OF THE
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Hayes/Winter

November 27, 2020

Opposition No. 91212834

Edge Games, Inc.

v.

Mobigame

BY THE TRADEMARK TRIAL AND APPEAL BOARD:

This case now comes up for consideration of Applicant's contested motion (filed August 6, 2020), 94 TTABVUE,¹ requesting reconsideration of the Board's January 23, 2020 Order, 92 TTABVUE, dismissing the opposition without prejudice as moot² in view of the cancellation of the International Registration from which Applicant's involved extension of protection to the United States was based.³ 94 TTABVUE 3.

¹ Citations to the record or briefs in this order include citations to the publicly available documents on TTABVUE, the Board's electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry. All citations to documents contained in the TTABVUE database are to the downloadable .pdf versions of the documents in the United States Patent and Trademark Office ("USPTO") TTABVUE Case Viewer.

² Applicant asks "the USPTO to reconsider its position and reinstate MOBIGAME's Appl. No. 79/067,304." ¶ 10, 94 TTABVUE 3.

³ An application for an extension of protection of an international registration to the United States under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), is referred to as a "66(a) application." *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP")

A request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date thereof. Trademark Rule 2.127(b), 37 C.F.R. § 2.127(b). Applicant's motion was filed more than six months after the Board's January 23, 2020 order. Accordingly, Applicant's motion for reconsideration is **DENIED** as untimely and will not be considered.⁴

For informational purposes, however, the Board hereby notifies Applicant that the cancellation of an international registration for failure to renew results in the **mandatory** abandonment of a pending 66(a) application for extension of protection of that international registration to the United States by the United States Patent and Trademark Office ("USPTO").⁵ *See* 15 U.S.C. § 1141j; Trademark Rule 7.30, 37

§ 602.01 (2020). Application No. 79067304 was filed January 12, 2009, based on Trademark Act Section 66(a), 15 U.S.C. § 1141f(a).

⁴ Additionally, the Board notes that Applicant's motion was not filed by U.S. counsel. Applicant is domiciled in France. *See* ¶ 2, 1 TTABVUE 7; ¶ 2, 22 TTABVUE 2. The request for reconsideration was filed by David Papazian, Applicant's Director. 94 TTABVUE 3-4. Effective August 3, 2019, parties to a proceeding before the Trademark Trial and Appeal Board ("the Board") whose domicile is not located within the United States or its territories must be represented by an attorney who is an active member in good standing of the bar of the highest court of a state in the United States, or the District of Columbia, or any Commonwealth or territory of the United States. *See* Trademark Rule 2.11, 37 C.F.R. § 2.11; *see also* Patent and Trademark Rules 11.1 and 11.14, 37 C.F.R. §§ 11.1 and 11.14. Applicant is advised that the Board **will not** consider any submission filed by Applicant in this proceeding, and **will not** issue an order in response thereto, unless the submission is filed by U.S. counsel representing Applicant.

The Board further notes that Applicant's motion for reconsideration was not accompanied by proof of service on Opposer, as required by Trademark Rule 2.119(a), 37 C.F.R. § 2.119(a).

⁵ The only exception to mandatory cancellation, inapplicable here, is that an applicant may request that the goods or services subject to cancellation in the 66(a) application be transformed to a Section 1 or 44 application. 15 U.S.C. § 1141j(c); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 1904.09 (October 2018). However, the request must be made within three months after cancellation of the international registration, and transformation is only available if the international registration was cancelled as a result of the basic application or registration upon which it was based being restricted, abandoned, cancelled, or expired. 15 U.S.C. § 1141j(c); *see also* TMEP § 1904.09.

C.F.R. § 7.30, TBMP § 602.01. Accordingly, there no basis upon which the Board can reinstate a Section 66(a) application when the international registration upon which it was based was cancelled due to the failure to renew.⁶ 15 U.S.C. § 1141j.

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Transformation is not available if the international registration expires for failure to renew, as in this case. *Id.*; *see also* 15 U.S.C. § 1141j(c).

⁶ The renewal of an international registration must be made with the International Bureau of the World Intellectual Property Organization. *See* TMEP § 1905. The USPTO does not process renewals of international registrations or send notices related to the renewal of an international registration. *Id.*